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OFFICE OF PETITIONS
AND APPEALS

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

In re Application of
Sun, Chan, Layer, Toulis,
Cheung, Ko, Fung, Halpin,
Yap, Chow, Leung, Yeung,
Tsim and Solomon
Application No. 09/495,393
Filed: January 31, 2000
For: System and Method for Integrating
Trading Operations Including the Generation,
Processing and Tracking of and Trade
Documents

This is in response to the petition under 37 CFR 1.47(a), filed June 22, 2000.

The petition is **dismissed**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on January 31, 2000 without an executed oath or declaration and naming Sun, Chan, Layer, Toulis, Cheung, Ko, Fung, Halpin, Yap, Chow, Leung, Yeung, Tsim as joint inventors. None of the named joint inventors executed the oath or declaration. It should be noted that Mr. Sol Solomon was not named as a joint inventor on this oath or declaration.

Accordingly, on April 6, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, the statutory basic filing fee, and a surcharge for late filing.

In response, on June 22, 2000, a Combined Declaration and Power of Attorney signed by Sun, Chan, Layer, Toulis, Cheung, Ko, Fung, Halpin, Yap, Chow, Leung, Yeung and Tsim was filed. This oath or declaration also named Mr. Solomon as a joint inventor, however, Mr. Solomon did not execute the document. Also filed on June 22, 2000 were the following: Petition for One (1) Month Extension of Time Under 37 CFR 1.136(a); Petition Under 37 CFR 1.47, signed by attorney of record Michael J. Scheer; Declaration of Mark Kessler (attorney for purported assignee Chase Manhattan Bank) in Support of Petition Under 37 CFR 1.47 with attached Exhibits; Exhibit A - February 7, 2000 cover letter from Mr. Scheer to Mr. Kessler with attached oath or declaration, facsimile transmittal sheet from Mr. Scheer to David Perkins and facsimile transmittal

report; Exhibit B - February 7, 2000 cover letter from Mr. Scheer to Mr. Perkins; and Exhibit C- February 18, 2000 cover letter from Mr. Scheer to Mr. Perkins. The above mentioned filing fee and surcharge, as well as a one (1) month extension of time fee were also paid by check with the June 22, 2000 filing.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Applicant lacks items (1), (2) and (4) set forth above.

As to Item (1), it is unclear whether Mr. Solomon, the non-signing inventor, was presented with a complete copy of the application papers (specification, claims and drawings). Moreover, the petition lacks proof that Mr. Solomon refuses to sign the oath or declaration. See MPEP 409.03(d).

In his declaration, Mr. Kessler indicates that between December 17, 1999 and December 20, 1999, a Taiwanese patent application and formal documents were provided to Mr. Solomon by Ms. Yap, a co-inventor. During phone conversations with Mr. Kessler and Ms. Yap on or about December 20-22, 1999, Mr. Solomon indicated that he refused to sign the Declaration and Power of Attorney at that time. However, petitioner fails to provide an affidavit executed by Ms. Yap indicating what documents she provided to Mr. Solomon and whether these documents included a complete copy of the United States application papers (specification, claims and drawings) as required by MPEP 409.03(d).

After receiving a copy of the United States patent application (Serial No. 09/495,393) and copies of a Declaration and Power of Attorney from Mr. Scheer on or about February 7, 2000, Mr. Kessler states that he forwarded "these documents" to the inventors. It is unclear from both Mr. Kessler's affidavit and Mr. Scheer's cover letter (Exhibit A), whether the documents Mr. Kessler forwarded to the inventors included a complete copy of the U.S. application papers (specification, claims and drawings). Nevertheless, Mr. Kessler then states that he

did not, however, immediately forward the U.S. documents to Mr. Solomon in light of [Mr. Kessler's] recent efforts to obtain [Mr. Solomon's] signature on the Affidavits and Declarations and Power of Attorney for the Taiwanese Application.

Instead, Mr. Kessler indicates he directed Mr. David Perkins (a Chase employee in Australia) to "attempt to obtain [Mr. Solomon's] signature on the documents." According to Mr. Kessler, Mr. Perkins said that Mr. Solomon twice refused to sign "the documents", once during a phone conversation, and later during a face-to-face meeting. As was the case with Ms. Yap, however, petitioner fails to provide an affidavit executed by Mr. Perkins indicating what documents he provided to Mr. Solomon and whether these documents included a complete copy of the U.S. application papers (specification, claims and drawings) as required by MPEP 409.03(d), as well as Mr. Perkins' firsthand recounting of Mr. Solomon's refusals to sign.

Unless Mr. Solomon was presented with a copy of the application papers (specification, claims and drawings), he could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration which was allegedly

provided to him. Accordingly, Rule 47 applicant failed to show or provide proof that the inventor has refused to sign the declaration. See MPEP 409.03(d). Applicant should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show that the inventor has refused to join in the application.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration lacks a home address for Mr. Solomon, the non-signing inventor. See MPEP 409.03 (e) and 605.03. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is REQUIRED.

As to item (4), a proper statement of the inventor's last known address is missing and is required. Petitioner's "Statement of Last Known Address" for Mr. Solomon lacks a home address for the non-signing inventor. See MPEP 409.03(e) and 605.03.

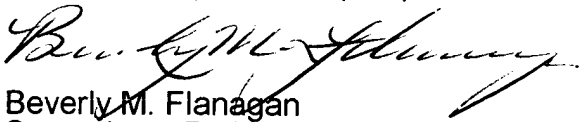
Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries related to this decision may be directed to Petitions Attorney Nelson B. Snyder III at (703) 305-0011.



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